

REMARKS

Claims 1-27 are pending in this application.

Claims 1, 12, 18, 22, and 23 are independent.

The participation of the Examiner and Supervisory Examiner in the Interview on September 24, 2002, the discussions at which are summarized in the Interview Summary of the same date, is noted with appreciation.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as obvious over Remington et. al. (U.S. Patent No. 6,070,150A) in view of Lemay, Teach Yourself Web Publishing With HTML 3.0 in a Week, 1996 and Wall Street *E Banking, 1/7/1997. The rejection is respectfully traversed.

Prior to discussing the features which distinguish the present invention over the applied prior art, it is perhaps first worthwhile to point out that in rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine the prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification

obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of obviousness, one must look to the collective teachings of the references relied upon and to whether the hypothetical person of ordinary skill in the art, familiar with such teachings, would have found it obvious to make a corresponding structure or process to that being claimed (See In re Fritch (23 USPQ 1780 (Fed. Circ. 1992))).

The test for combining references is not what the individual references themselves suggest, but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d 1826 (Fed. Circ. 1987))). Without a suggestion of the invention in the prior art reference combination, there is no motivation to combine the references.

Simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). The mere possibility that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious, unless the prior art suggests the desirability of the modification. In the absence of such a suggestion the basis for the rejection is nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski, supra).

The issue is not whether it is within the skill of the art to make the proposed modifications, but rather if one skilled in the art, on consideration of the references, would have found it obvious to do so. It should be recognized that the fact that the prior art could

be modified so as to result in the combination defined by the claims would not have made the modification obvious, unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and (In re Keller 208 USPQ 817 (CCPA 1981)).

As the Federal Circuit recently reiterated, if there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination. Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense.

It is respectfully submitted that the Examiner's conclusion of obviousness is not based on what the prior art shows, teaches or suggests, but rather on the Examiner's view of what one of ordinary skill would have considered to be common sense and simple. Thus, the Examiner's position is improper under law, as should be clear from the above.

It is further respectfully submitted that there is nothing within the applied art teachings which would suggest the Examiner's proposed combination to arrive at the invention claimed in the present application. Rather, the applied prior art lacks any suggestion of the combination of features recited in each of the independent claims. Also lacking is any recognition that such a combination of features could be beneficial. Additionally, it is unclear (and the Examiner has failed to provide any explanation of) how one skilled in the art one could go about modifying the applied references to arrive at the subject invention.

MPEP §707.07 clearly requires that "before ... rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be fully applied" (emphasis added), so as to deal justly with

the applicant as well as the public. The Manual goes on to state that “present practice does not sanction hasty and ill-considered ... rejections”. “The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end.” “The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed ...”(emphasis added).

MPEP § 707.07(g) instructs an Examiner that “[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression”. Omnibus rejections are to be avoided. Hence, a plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the group. (See MPEP §707.07(d)).

The Examiner rejects all claims based on a general reference to “at least columns 1-20 and in particular, columns 3-8 and 16-17” of Remington, “at least pages 4-11 and 114-115” of Lemay and “pages 1-3” of Wall. The Examiner fails to identify any particular disclosure within these references which suggests the explicit features recited in each of the present claims. Hence, the Examiner has made an omnibus rejection of the claims, without consideration of the specific limitations recited in each claim. Indeed, it appears that the Examiner has ignored numerous limitations recited in each of the independent claims, as well as dependent claims.

With regard to Remington, the Examiner states that “Remington generally describes the capabilities of the Internet to cross access information through hyperlinks to sites and databases, but Remington does not fully describe these capabilities”. However, the Examiner then baldly asserts “it would have been obvious to one skilled in

the art at the time of the invention to use cross linked hyperlinks to enable the consumer to access information at the sites of both the aggregator and the payee from each other's sites because that would be common sense, knowing that a consumer would want to contact the original payee in the event of questions about their bill, as the aggregator would not normally know the details the payee would, and the payee would not normally have the latest status of payment that the aggregator would, and each would have a different set of data from the consumer database to present to each individual consumer at their site".

It is first respectfully submitted that, as noted above, what the Examiner considers to have been common sense at the time of the invention is irrelevant. Furthermore, as will be discussed further below, the relevance of the Examiner's assertions to the claimed invention is entirely unclear.

The Examiner's contentions regarding Lemay's disclosure are also not understood.

Here again, the Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to use cross linked hyperlinks to enable the consumer to access information in different formats at the sites of both the aggregator and the payee from each other's sites because that would be common sense in a very simple procedure". However, common sense and simplicity, according to the Federal Circuit, cannot form the basis of an obviousness rejection.

The Examiner asserts that Wall describes how simple their bill presentment is to "receive, review, and pay bills presented on the Internet in different formats, which system incorporates features described in Remington and Lemay and contained in claims 1-27", but fails to identify where within the reference itself these bald assertions are supported.

The Examiner then goes on to state that "it would have been obvious to one skilled in the art at the time of the invention to use cross linked hyperlinks to enable the consumer to access information in different formats at the sites of both the aggregator and the payee from each other's sites because that would be common sense". Here again, the relevance of the Examiner's statements cannot be understood and the basis for the rejection appears to be entirely inconsistent with law and the mandates set forth in the rules of practice.

The Examiner concludes with a statement that all claims are obvious over the applied art combination "because it would have made common sense and provided a more flexible and cost efficient system of bill presentment and payment communications to the consumer, it would have been obvious to one skilled in the art at the time of invention to add the teachings of Lemay and Wall to those of Remington, and to add those of Remington to those of the others for the same reason." One can only ask how the teachings of the respective references could be combined to correspond to the invention recited in the present application and what would motivate such a combination.

In summary, it is respectfully submitted that the Examiner has failed to establish a prima facie basis for the rejection, has at best made an omnibus rejection on the basis of a hindsight reconstruction of the claimed invention, and has misapplied the law as well as the rules.

With regard to distinguishing aspects of the invention, claim 1 requires that a central station transmit bill availability information which identifies available bills for multiple users. A first user station associated with a first user is linked to a first network address associated with a first biller based on the selection of the bill of that biller for the first user by the first user station, from the transmitted availability information. A second

user station associated with a second user is linked to a second network address which is also associated with the first biller based upon a selection of the bill of that biller for the second user by the second user station, from the transmitted availability information.

It is respectfully submitted, as discussed at the interview, that the applied prior art lacks any teaching or suggestion of providing different users with information indicative of the availability of a bill from a single biller and linking each of those user's to a different biller site based on the selection of the applicable user's bill. Furthermore, it is respectfully submitted that the Examiner has failed to identify any disclosure within the applied prior art, which in any way, suggests that different users should be linked to different biller sites to access their respective bill from the same biller.

Independent claim 12 is distinguishable on similar grounds.

Independent claim 18 recites a memory configured to store identifiers of available bills and network addresses at which the identified bills are available, including a first bill identifier which identifies a first available bill of a first biller for a first user and a second bill identifier which identifies a second available bill of the first biller for a second user. Also required is a processor to direct the transmission of the stored first bill identifier to the first user with a first network address and the stored second bill identifier to the second user with a second (different) network address, the first bill with certain other information being available at the first network address, while the second bill, without this other information is available at the second address.

It is respectfully submitted that the Examiner has failed to identify such a memory or processor. Further, the Examiner has failed to identify any suggestion in the applied prior art that identifiers of available bills of a single biller should or could be transmitted to different users with different network addresses at which the bills themselves are available. Furthermore, the applied prior art lacks any suggestion that storing bills of

the same biller at different network addresses could be beneficial. Additionally, the applied prior art lacks any suggestion that bills of a single biller could or should be stored at different network addresses, such that the bill available to one user at one address will have information which is not included with the bill available to another user at the other address.

Similarly, the applied prior art lacks any suggestion of the database recited in independent claim 22, which requires that identifiers of bills of one biller be associated with multiple different network location indicators, each indicating a location at which a bill of the biller is available.

Independent claim 23 is distinguishable for reasons which should be clear from the above.

It is further respectfully submitted that other features recited in the dependent claims further and independently distinguish over the applied prior art. For example, claim 9 requires that a third user be linked to the first network address of the biller based on a bill selection in order to make payment of the bill. The Examiner appears to have completely ignored this feature as well as various other features recited in the dependent claims.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 1-27.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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